

REMARKS

Claims 2-26 and 29-36 were pending in this application.

Claims 8-26 and 29-36 have been withdrawn from consideration and are hereby cancelled without prejudice.

Claims 2-7 have been rejected.

Claims 2, 3, 6, and 7 have been amended as shown above.

Claims 37-50 have been added.

Claims 2-7 and 37-50 are now pending in this application.

Reconsideration and full allowance of Claims 2-7 and 37-50 are respectfully requested.

I. **REJECTION UNDER 35 U.S.C. § 103**

Claims 2-7 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,046,762 to Sonesh et al. ("*Sonesh*") in view of U.S. Patent No. 5,327,486 to Wolff et al. ("*Wolff*"). This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima*

facie case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. (*MPEP* § 2142).

Claim 2 recites that "call reception logic" operates to "query capabilities of [a] particular remote telephone station prior to sending [a] data information message," where a

“format for the data information message” is “determined based upon the capabilities of the particular remote telephone station.”

The Office Action acknowledges that *Sonesh* fails to disclose these elements of Claim 2. (*Office Action, Page 3, Second paragraph*). The Office Action then asserts that *Wolff* discloses these elements of Claim 2 and that it would be obvious to combine *Sonesh* and *Wolff*. (*Office Action, Page 3, Third paragraph*).

Wolff recites a system and method for managing telephone calls using a personal telephone manager (PTM) 12. (*Abstract*). A portable computer 18 used by a called party may transmit a text message to the personal telephone manager 12, which converts the text message into audio for delivery to a calling party. (*Abstract; Col. 5, Lines 1-6*). The called party could also select a pre-recorded voice message to be presented to the calling party. (*Col. 5, Lines 57-61*). In addition, the personal telephone manager 12 could use speech-to-text conversion or voice recognition to allow the calling party to identify himself or herself, and the text is then transmitted to the called party's portable computer 18. (*Col. 7, Lines 5-14*).

Wolff simply recites a system where text from a called party is converted into speech for a calling party and where speech from the calling party is converted into text for the called party. Nowhere does *Wolff* recite that any type of “query” is performed to determine the “capabilities” of a device used by the calling party or the called party. For example, *Wolff* lacks any mention of querying the capabilities of the portable computer 18 used by the called party or querying the capabilities of the telephone used by the calling party. As a result, *Wolff* fails to disclose, teach,

or suggest “call reception logic” that operates to “query capabilities of [a] particular remote telephone station prior to sending [a] data information message” as recited in Claim 2.

Wolff also lacks any mention that the “format” of data for the calling party or called party’s device is “determined based upon the capabilities” of the calling party or called party’s device. Rather, *Wolff* simply converts text from the called party into speech for the calling party without any consideration of the “capabilities” of the calling party’s telephone as determined during a “query.” Similarly, *Wolff* simply converts speech from the calling party into text for the called party without any consideration of the “capabilities” of the called party’s portable computer 18 as determined during a “query.” As a result, *Wolff* fails to disclose, teach, or suggest that a “format for the data information message” is determined “based upon the capabilities of the particular remote telephone station” as recited in Claim 2.

For these reasons, the Office Action does not establish that the proposed *Sonesh-Wolff* combination discloses, teaches, or suggests all elements of Claim 2. Because of this, the Office Action does not establish a *prima facie* case of obviousness against Claim 2 (and its dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 2-7.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining claims in the application are in condition for allowance and respectfully requests an early allowance of such claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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